

REMARKS

The comments of the Examiner as set forth in the official office action have been carefully studied and reviewed. In this response, claims 1, 2, 44 and 56 have been amended. New claims 61-65 have been added.

First, with respect to the new claims that have been added, new claim 61 parallels former claim 10 which was indicated to contain allowable subject matter. Therefore, claim 61 is in condition for allowance. Claims 62 and 63 depend directly or indirectly from claim 61 and therefore they too are in condition for allowance.

New claim 64 parallels former claim 51. Claim 51 in the last office action, was indicated to contain allowable subject matter. Therefore, claim 64 is allowable. Claim 65 depends from claim 64 and is therefore also allowable.

Claim 1 as amended herein is as follows:

A modular I-beam comprising:

- a. a first set of elongated nested channels;
- b. a second set of elongated nested channels disposed in back-to-back relation with said first set of elongated nested channels;
- c. each channel including a web; and
- d. one or more fasteners extending through the webs of the channels and securing said first and second sets of elongated nested channels together.

Paragraph d of claim 1 calls for one or more fasteners extending through the webs of the channels and securing the first and second sets of elongated nested channels together. Claim 1, as amended in the last office action, stands rejected as being unpatentable under 35 USC §103(a) in view of the Farley patent, U.S. Patent No. 5,394,906. Apparently, the Examiner does

not believe that claim 1, even before amended herein, is anticipated by Farley. The Examiner points to Figure 2 of the Farley patent. Figure 2 is a depiction of a prior art device that is basically a cross section of a curved frame 100 that is made from fiber. Apparently, the fiber is utilized to make a composite structure. The C-shaped sections 101 shown in Figure 2 are not secured together by a fastener that extends through the web of the first and second sets of elongated nested channels. Indeed, the discussion of Figure 2 of Farley as found in column 2 of the Farley patent, does not say anything about any means employed for fastening the C-sections together. More particularly, the Farley patent does not discuss or suggest extending fasteners through the web portions of the C-sections to connect the nested sections together.

Claim 44 has likewise been amended to clearly define over Farley. Here, the method set forth in paragraph d calls for fastening said first and second sets of elongated nested channels together by inserting at least one fastener through webs that form a part of each set of nested channels.

It is noted that the office action first rejects claims 1-3 and claim 9 as being obvious in view of Farley. However, it does not appear that the Patent Office has set forth sufficient findings to form a prima facie case of obviousness, which is required by law and the MPEP. The Examiner does conclude that the use of some type of securing means, such as an adhesive, is deemed obvious. This is a conclusionary statement that is unsupported by substantial evidence. The Farley patent appears to be silent as to whether the C-sections in Figure 2 are indeed secured together or not, and is particularly silent as to any means or structure for securing them together. Claims 1 and 44, now call for a fastener to extend through the web of the respective sets of elongated nested channels for securing them together. Such a structure is not taught or suggested by the prior art. More particularly, claims 1 and 44 clearly define over the structure shown in Figure 2 of the Farley patent.

In order to make out a prima facie case of obviousness, the Examiner must point to something in the record or in the general knowledge of a person of ordinary skill in the art that

would cause that person to be induced to modify the primary reference as indicated by the Patent Office. In other words, there must be some motivation to alter the primary reference to yield the claimed invention. In the case of the rejection of claims 1-3 and 9 on Farley, the rejection cannot be supported by simply concluding that the modification is deemed obvious. With all due respect that is not the test. To the contrary, the Patent Office must point to something in the record that would show that a person of ordinary skill in the art would be motivated to alter the primary reference. The Examiner has not even maintained that a person of ordinary skill in the art would be motivated. The Examiner simply concluded that use of an adhesive to secure the channels together is deemed obvious. That is a conclusionary statement and can never serve as a basis for a §103 rejection.

In order to prevent a hindsight based obviousness analysis, the Federal Circuit has established that in determining the scope and content of the prior art, that the Patent Office must determine if there is a reason or motivation that would have led a person of ordinary skill in the art to modify the primary reference. See *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1988). In *Rouffet*, the Federal Circuit held that the Patent Office must identify specifically the reasons a person of ordinary skill in the art would have been motivated to first select a reference and then modify the reference to render the claimed invention obvious. These findings must be particularly set forth. See *In re Dembizak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). These specific findings cannot be broad conclusionary statements because broad conclusionary statements, as stated by the Federal Circuit, are not evidence. *Id.* The Patent Office must explain when analyzing the prior art what specific understanding or technical principle would have suggested the modification. *Rouffet*, 169 F.3d at 1357, 47 U.S.P.Q.2d at 1659. In this case, particularly with respect to the rejection of claim 1, the Patent Office has not met its burden.

Notwithstanding, the amended claims do not simply claim fastening means or securing means for securing the nested channels together. The claims call for one or more fasteners extending through the webs of the channels for securing the nested channels together.

For the foregoing reasons, it is respectfully urged that the present application is in condition for allowance and allowance is respectfully requested.

A check in the amount of \$129.00 is enclosed for the additional claims. If additional fees are required please charge them to Deposit Account No. 18-1167.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

Respectfully submitted,

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4/30/03

"Version with markings to show changes made."

1. (Amended twice) A modular I-beam comprising:

- a. a first set of elongated nested channels;
- b. a second set of elongated nested channels disposed in back-to-back relation with said first set of elongated nested channels; [and]
- c. each channel including a web; and
- d. one or more fasteners extending through the webs of the channels and securing said first and second sets of elongated nested channels together.

2. (Amended) The modular I-beam of claim 1 wherein said first and second sets of nested channels are constructed of steel and comprise at least one channel pair.

44. (Amended twice) A method of constructing a modular I-beam, said method comprising:

- a. forming a first set of elongated nested channels;
- b. forming a second set of elongated nested channels;
- c. disposing said first and second sets of elongated nested channels in back-to-back relation to one another; and
- d. fastening said first and second sets of elongated nested channels together by inserting at least one fastener through webs that form a part of each set of nested channels.

56. (Amended) The method of claim 44 further comprising:

- a. forming aligned openings in the webs of said nested channels; and

b. inserting [said] a series of fasteners through said aligned openings in the webs to secure said first and second sets of nested channels together.